

Docket No.: 19226/931 (R-5495)

RECEIVED
SEP 04 2001
TECH CENTER 1600/2900
#11
[Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hangauer et al.)
Serial No. : 09/482,585)
Cnfrm No. : 7206)
Filed : January 13, 2000)
For : A NOVEL METHOD FOR DESIGNING)
PROTEIN KINASE INHIBITORS)

Examiner:
T. Prasthofer
Art Unit:
1627

RESPONSE TO RESTRICTION REQUIREMENT AND ELECTION OF SPECIES

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

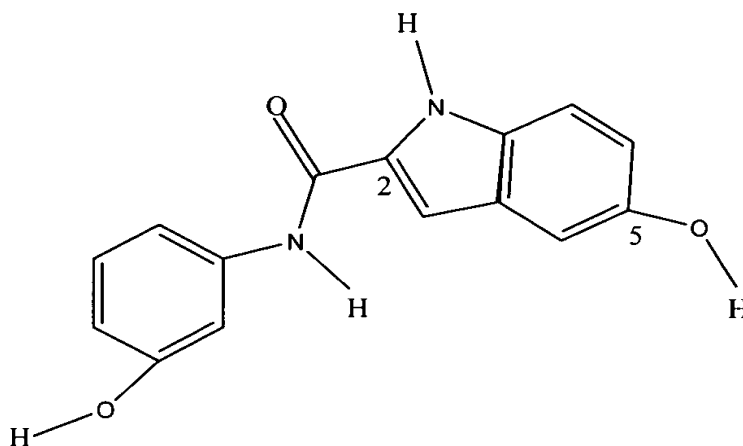
In response to the March 28, 2001, written restriction requirement, applicants hereby elect Group V (i.e., claims 1-20 (in part) and 22), drawn to a method for identifying inhibitors of protein kinases, with traverse. In accordance with page 4 of the written restriction requirement, applicants further elect "wherein the second group consists of indole," with traverse.

However, applicants submit that all groups of invention identified in the outstanding office action are closely related and, therefore, would require common areas of search and consideration. At a minimum, applicants submit that the inventions of Groups VI and VII, which use a product produced by the method of Group V as a starting material, should be examined with Group V. Further, applicants submit that the invention of Group VI should be examined with the claims of Group V, as set forth in the prior oral restriction requirement on October 25, 2000.

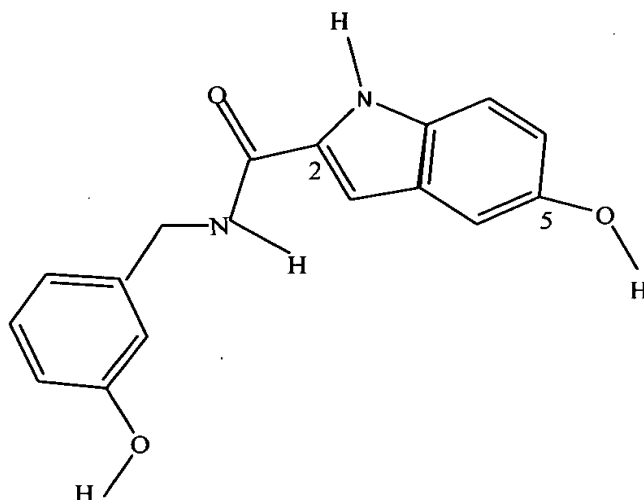
Moreover, to the extent the basis, in part, for the above restriction requirement is to defer examination of certain structures for the second group (or module), such a requirement is and should be an election of species requirement (see MPEP § 803.02, which requires the examiner to impose a provisional election of a single species, and not a restriction requirement, for Markush-type claims including independent and distinct inventions, as in claims 9, 28, and 55 of the present invention). Thus, with regard to the structures for the second group claimed in Groups IV-VII, the proper course in the instant application is to require only an election of species at this time, and not to impose a restriction requirement.

On the basis of the foregoing, applicants respectfully request reconsideration of the outstanding written restriction requirement and submit that the claims of Groups I, II, III, IV, V, VI, and VII should be examined on the merits at this time.

Further, in response to the election of species requirement, applicants hereby elect: (1) Ac-Ile-Tyr-Gly-Glu-Phe-NH₂ as the peptide scaffold; (2) a hydroxyl group as the functional group of claim 3; (3) the following protein kinase inhibitor structure:



and (4) the following modified protein kinase inhibitor structure:



with traverse. Claims reading on the elected species include claims 1-4, 6, 9-20, and 22.

Applicants hereby traverse the election of species requirement on the ground that examination of the presently claimed invention can be conducted without significant burden in the absence of reliance on the above-elected species.

Applicants submit that, at a minimum, the elected subject matter is allowable and, therefore, the claims should be examined to the extent of the presently claimed genus.

Applicants further submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: August 28, 2001

Georgia Evans
Georgia Evans
Registration No. 44,597

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603
Telephone: (716) 263-1672
Facsimile: (716) 263-1600

Certificate of Mailing - 37 CFR 1.8(a)	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below.	
<u>Aug. 28, 2001</u>	<u>Ruth R. Smith</u>
Date	Ruth R. Smith